

of the claimed invention. In particular, the Examiner states that the original specification does not appear to support the ranges for brew solids and Delta Standard set forth in Claim 8. Actually, the Examiner's rejection takes issue with the "less than about 30%" language as applied to the brew solids.

Applicants have canceled Claim 8 without prejudice, and have submitted in its place new Claim 34 to which all remaining claims now depend. The limitation noted above does not exist in new claim 34--namely, "less than about 30%" for the brew solids.

Applicants therefore request reconsideration of remaining Claims 9-33 and new Claim 34 in light of Applicants amendments over the Examiner's 35 U.S.C. § 112, first paragraph, rejection.

35 U.S.C. § 103(a) Rejections

Claims 8-19, 24-26 and 31-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EP No. 0893065. Claim 8 has been canceled without prejudice. New Claim 34 has been added. In light of the addition of new Claim 34 and its attendant subject matter, Applicants will discuss the relevance of EP '065 as it pertains to Claim 34 and the remaining claims.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. (MPEP § 2142).

EP '065 merely teaches brewing an extract, packaging the extract, and then placing the extract on a shelf in a store for purchase later by a consumer. Applicants respectfully contend that this "process" teaches away from Applicants' process of brewing an extract and then storing the extract in a brewer for later dilution of the extract within the brewer as is clearly taught and claimed by Claim 34. Second, the extract in the '065 reference is not meant to create Applicants' individually-tailored coffee servings directly from a brewing apparatus. Nor, does the '065 reference teach or suggest this kind of coffee delivery nor the storage of extract within the brewer. Without such teaching or suggestion of the elements noted above a rejection grounded in obviousness is not met.

Therefore, Applicants respectfully request reconsideration and allowance of Claims 9-19, 24-26 and 31-33 over the Examiner's 35 U.S.C. § 103(a) rejection.

Claims 8-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kalenian (U.S. Patent No. 6,203,837). Claim 8 has been canceled. New Claim 34 has been added.

Kalenian '837 merely provides creation of an extract that is then removed from its origin of formation, i.e., the brewer. That extract is then subsequently used in a different apparatus outside of the extract brewer to produce its intended beverage, e.g., coffee. As noted above for the '065 reference, Applicants respectfully assert that this process teaches away from Applicants' extract-brew and dilute process.

By citing Kalenian '837, Applicants respectfully assert that the Examiner has not met the requirements for a statutory case of obviousness under 35 U.S.C. § 103(a) and requests reconsideration and allowance of Claims 9-34 over Kalenian '837.

Respectfully submitted,

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MARKED COPY OF AMENDED CLAIMS

9. (Amended) A process according to Claim [8] 34 for making a customized coffee beverage product by delaying dilution of a coffee extract for a period of time in excess of about 15 minutes after the onset of brewing of the extract.
14. (Amended) The process of Claim [8] 34 wherein the coffee extract is prepared from ingredients comprising an extract portion of water and a dry, roast and ground coffee, and the weight ratio of the extraction portion of water to the dry, roast and ground coffee is in the range of from about 5:1 to about 24:1.
18. (Amended) The process of Claim [8] 34 wherein the coffee extract is diluted at a coffee extract to water ratio in the range of from about zero to about 1:15.
20. (Amended) The process of Claim [8] 34 wherein the coffee extract has a brew solids of less than about 10%.
24. (Amended) The process of Claim [8] 34 wherein the coffee extract has a minimum brew solids of greater than about 1.2%.